



UNITED STATES DEPARTMENT OF COMMERCE  
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SERIAL NUMBER	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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07/841,910 02/26/92 WARD

D 1280-4014-US

EXAMINER

CRANE, L

18N1/0707

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NEW YORK, NEW YORK 10017

ART UNIT

PAPER NUMBER

36

1803

DATE MAILED:

07/07/94

This is a communication from the examiner in charge of your application.  
COMMISSIONER OF PATENTS AND TRADEMARKS

☒ This application has been examined ☒ Responsive to communication filed on 11/23/93 ☐ This action is made final.

A shortened statutory period for response to this action is set to expire 3 month(s), ----- days from the date of this letter.  
Failure to respond within the period for response will cause the application to become abandoned. 35 U.S.C. 133

Part I THE FOLLOWING ATTACHMENT(S) ARE PART OF THIS ACTION:

- |   |  |
|---|--|
| 1. <input checked="" type="checkbox"/> Notice of References Cited by Examiner, PTO-892. | 2. <input type="checkbox"/> Notice re Patent Drawing, PTO-948.                   |
| 3. <input type="checkbox"/> Notice of Art Cited by Applicant, PTO-1449.                 | 4. <input type="checkbox"/> Notice of Informal Patent Application, Form PTO-152. |
| 5. <input type="checkbox"/> Information on How to Effect Drawing Changes, PTO-1474.     | 6. <input type="checkbox"/> _____  |

Part II SUMMARY OF ACTION

1. ☒ Claims 152-155, 158-161, 164-174 ----- are pending in the application.  
Of the above, claims ----- are withdrawn from consideration.
2. ☒ Claims 101-103, 110-112, 138, 148, 156-157 and 162-163 have been cancelled.
3. ☐ Claims ----- are allowed.
4. ☒ Claims 152-155, 158-161 and 164-174 ----- are rejected.
5. ☐ Claims ----- are objected to.
6. ☐ Claims ----- are subject to restriction or election requirement.
7. ☐ This application has been filed with informal drawings under 37 C.F.R. 1.85 which are acceptable for examination purposes.
8. ☐ Formal drawings are required in response to this Office action.
9. ☐ The corrected or substitute drawings have been received on -----. Under 37 C.F.R. 1.84 these drawings are ☐ acceptable. ☐ not acceptable (see explanation or Notice re Patent Drawing, PTO-948).
10. ☐ The proposed additional or substitute sheet(s) of drawings, filed on ----- has (have) been ☐ approved by the examiner. ☐ disapproved by the examiner (see explanation).
11. ☐ The proposed drawing correction, filed on -----, has been ☐ approved. ☐ disapproved (see explanation).
12. ☐ Acknowledgment is made of the claim for priority under U.S.C. 119. The certified copy has ☐ been received ☐ not been received  
☐ been filed in parent application, serial no. -----; filed on -----.
13. ☐ Since this application appears to be in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11; 453 O.G. 213.
14. ☐ Other

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EXAMINER'S ACTION

Art Unit 1803

The Group and/or Art Unit location of your application in the PTO has changed. To aid in correlating any papers for this application, all further correspondence regarding this application should be directed to Group 1800, Art Unit 1803.

5        Claims cancelled include 101-103, 110-112, 138, 148, 156-157 and 162-163.

The claims remaining in the case are **152-155, 158-161 and** new claims **164-174**. This is a total of 17 claims left for consideration.

10       Applicant's submission of a terminal disclaimer is herein noted. This document has been entered as paper no. 35 and the disclaimer has been approved.

15       Claims **152-155, 158-161 and 168-169 and 174** are rejected under 35 U.S.C. 112, first paragraph, as the disclosure is enabling only for claims limited in accordance with the specific embodiments. See MPEP 706.03(n) and 706.03(z).

20       In claims **167 and 174** the terms "m", "n" and "p" are defined in a manner which may be interpreted to include nucleic acids of any size, i.e. no upper limit has been specified. In view of the limited scope of the instant disclosure, and in view of the guidance provided by *Amgen v. Chugai* noted in a prior office action and repeated below, the scope of the claimed subject matter is deemed to be excessive.

Appropriate corrections are requested.

Art Unit 1803

Applicant's arguments filed November 23, 1993, and documents filed January 24, 1994 and February 15, 1994 have been fully considered but they are not deemed to be persuasive.

5 The following argument is repeated from the prior office action as it appears to continue to apply.

Applicant is referred to *Amgen v. Chugai*, 18 USPQ 2d 1016, at p. 1026 (CAFC 1991) wherein it seems that the absence of specific embodiments in reasonable proportion to the body of claimed subject matter was the basis for upholding the examiner's rejection, a  
10 situation which appears to be closely analogous in view of the vast array of compounds and their biochemical immunocomplexes being claimed herein, and applicant's reliance solely on the prior art for allegations in support of enablement. Applicant is requested to note that a patent is not a hunting license, paraphrasing *Brenner v.*  
15 *Manson*, 148 USPQ 689 (1966). It is well known and established that "law requires that disclosure in an application shall inform those skilled in the art how to use applicant's alleged discovery, not how to find out how to use it for themselves." *In re Gardner et al.*, 166 USPQ 138 (CCPA 1970).

20 Claims **152-155, 158-161 and 164-174** are rejected under 35 U.S.C. 112, first and second paragraphs, as the claimed invention is not described in such full, clear, concise and exact terms as to enable any person skilled in the art to make and use the same, and/or for failing to particularly point out and distinctly claim the  
25 subject matter which applicant regards as the invention.

Art Unit 1803

5 In claims **164, 167, 173 and 174** the descriptions of the variable "A" and attachments thereto such as "the detectable polypeptide" clearly encompass very large areas of subject matter totally unexplored by applicant. The metes and bounds of claimed subject matter are not readily discernable to the ordinary practitioner confronted with such terminology. And the very vastness of the subject matter encompassed clearly exceeds the scope of the specific embodiments within the instant disclosure.

Appropriate correction is requested.

10 Applicant's arguments filed November 23, 1993, and documents filed January 24, 1994 and and February 15, 1994 have been fully considered but they are not deemed to be persuasive.

15 Applicant is referred to the *Amgen v. Chugai* citation above. The instant terminology remains inappropriate indefinite and overly broad and therefore inappropriate.

Applicants submission of February 15, 1994 has been noted and the literature references therein have been made of record on a PTO-892 form attached hereto.

20 Papers related to this application may be submitted to Group 1800 via facsimile transmission(FAX). The transmission of such papers must conform with the notice published in the Official Gazette (1096 OG 30, November 15, 1989). The telephone number for the FAX machines operated by Group 1800 is (703) **305-3014**. The machine operator may be reached at (703) **308-4744**.

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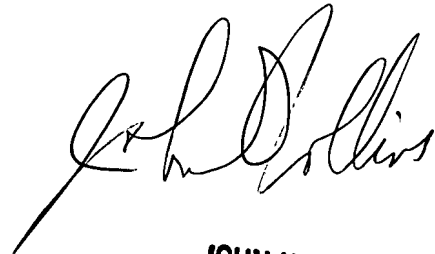
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Art Unit 1803

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner L. E. Crane whose telephone number is 703-**308-4639**.

5 Any inquiry of a general nature or relating to the status of this application should be directed to the Group 1800 receptionist whose telephone number is 703-**308-0196**.

LECrane:lec  
7/6/94



JOHN W. ROLLINS  
PRIMARY EXAMINER  
ART UNIT 183